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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/646,020  | 08/22/2003  | Thomas Soares        | LON-002             | 9249             |
| 53830 7590 05/28/2008<br>KOKKA & BACKUS, PC<br>200 PAGE MILL ROAD<br>SUITE 103<br>PALO ALTO, CA 94306 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| AHN, SANGWOO  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/646,020

**Applicant(s)**

SOARES ET AL.

**Examiner**

SANGWOO AHN

**Art Unit**

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/2008 has been entered.

### ***Response to Amendment***

2. Claims 16 – 35 are pending in the present application.  
Claims 1 – 15 have been canceled.  
Claims 16, 23, 32, 33 and 34 have been amended.

### ***Response to Arguments***

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 16 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zellweger (US 5,630,125) in view of Miller (US 2003/0036925).**

■ Regarding claim 16, Zellweger teaches,

A process, comprising:

displaying an IT services catalog (column 10 lines 11 - 12, column 11 line 10, et seq.),

presenting one or more options associated with the IT services catalog (column 8 lines 65 – 67, et seq.);

determining if an option is selected, the option indicating a request to provide assistance with selecting one or more IT services from the IT services catalog (column 8 lines 65 – 67, et seq.);

displaying a question if the request is detected, wherein the question is evaluated using a decision tree (column 8 lines 25 – 31, et seq.);

traversing the decision tree based upon one or more answers, in customer terminology (column 9 lines 20 – 27; 46 - 48, column 11 lines 21 - 24: supports multiple ways of conducting a search to ensure that differences in word usage do not impede access to a product, column 25 lines 26 – 32: add synonym), received in response to the question until one or more service actions are determined (column 7 line 62 – column 8 line 3, et seq.);

identifying one or more service actions based upon one or more answers  
(column 8 lines 25 – 27; 60 - 62, et seq.);

receiving data in a field in a data structure based upon the one or more answers  
(column 8 lines 30 - 31, column 26 lines 58 - 61, column 27 lines 18 - 26, et seq.);

requesting input associated with one or more unpopulated fields associated with  
the data structure, wherein the input is used to determine the one or more service  
actions (traversing the decision tree until target destination is reached requires  
unpopulated fields to be filled before all questions are answered).

Zellweger does not explicitly disclose validating the input to configure one or  
more IT services, in IT terminology, associated with one or more service actions  
(column 27 lines 18 – 27, et seq.).

However, Miller discloses validating the input to configure one or more IT  
services, in IT terminology, associated with one or more service actions (Figure 5  
element 507, paragraph 53 lines 2 – 14, et seq.). It would have been obvious to one of  
ordinary skill in the data processing art at the time the invention was made to modify the  
system of Zellweger with the teachings of Miller, wherein the system of Zellweger would  
have incorporated the teachings of Miller in order to allow a user create service forms  
efficiently, without being a skilled programmer, to streamline the process of filling out  
service forms for a information system, thus saving order entry time, as taught by Miller  
(paragraph 8, et seq.).

■ Regarding claim 17, Miller discloses validating the one or more answers using  
a constraint (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9;

16 – 19; 22 – 23, et seq.), rejecting the one or more answers if the constraint is violated or the one or more answers are validated, and providing another question if the one or more answers are rejected (Figure 5 element 508, paragraph 73 lines 1 – 4, et seq.).

■ Regarding claim 18, Miller discloses validating the one or more answers using a validation formula (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.), rejecting the one or more answers if the validation formula indicates the one or more answers are invalid, and providing another question if the one or more answers are rejected (Figure 5 element 508, paragraph 73 lines 1 – 4, et seq.).

■ Regarding claim 19, Miller discloses the constraint is stored in one or more attributes of the data field in the data structure (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.).

■ Regarding claim 20, Miller discloses the constraint is stored in a service advisor, the service advisor being configured to provide assistance (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.).

■ Regarding claim 21, Miller discloses another field in the data structure is filled in automatically based upon the one or more answers (paragraph 98 lines 32 – 35, Figure 5 element 505, et seq.).

■ Regarding claim 22, Miller discloses a dialog box presenting a suggested default answer based upon configuration attribute data associated with each of the one or more unpopulated fields (Figure 4 element 402 – 432; 438 – 456, Figure 4, paragraph 38 lines 12 – 15, et seq.).

■ Regarding claim 23, Zellweger discloses,

A process, comprising:

displaying an IT services catalog comprising one or more IT services (column 10 lines 11 - 12, column 11 line 10, et seq.);

determining if a service action is selected to create an instance of the one or more IT services (column 8 lines 65 – 67, et seq.);

launching a service advisor, wherein the service advisor uses a decision tree if the serve action is not selected (column 8 lines 65 – 67, et seq.);

displaying one or more questions, wherein the one or more questions are presented according to the decision tree, the decision tree having one or more recommendations associated with the one or more IT services (column 7 line 62 – column 8 line 3, column 8 lines 25 – 31, et seq.);

identifying one or more IT services based upon the one or more answers (column 8 lines 25 – 27; 60 - 62, et seq.);

receiving data, in IT terminology, into one of more fields of one or more data structures associated with the one or more IT services (column 8 lines 30 - 31, column 26 lines 58 - 61, column 27 lines 18 - 26, et seq.); and

requesting input associated with one or more empty fields of the one or more data structures, wherein the one of more empty fields comprise relationship fields used to define the one or more IT services (traversing the decision tree until target destination is reached requires unpopulated fields to be filled before all questions are answered).

Zellweger does not explicitly disclose validating one or more answers received in response to one or more questions (column 27 lines 18 – 27, et seq.).

However, Miller discloses disclose validating one or more answers received in response to one or more questions (Figure 6 element 603, Figure 5 element 507, paragraph 53 lines 2 – 14, et seq.). It would have been obvious to one of ordinary skill in the data processing art at the time the invention was made to modify the system of Miller with the teaching of Chiang as discussed above in the analysis of claim 16.

■ Regarding claims 24 – 26, Miller discloses the one or more empty fields are filled using a pointer to one or more service actions/IT resource, based upon the one or more answers and the input (paragraph 46 lines 4 – 7; 9 – 13; 13 – 17, paragraph 98 lines 32 – 35, et seq.).

■ Regarding claim 27, Miller discloses using a constraint stored in one or more attributes of the one or more fields of the one or more data structure (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.).

■ Regarding claim 28, Miller discloses the constraint is a validation formula (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.).

■ Regarding claim 29, Miller discloses using a constraint stored in the service advisor (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.).

Regarding claim 30, Miller discloses one or more dialog boxes (Figure 4 element 402 – 432; 438 – 456, Figure 4, paragraph 38 lines 12 – 15, et seq.).



■ Regarding claim 31, Miller discloses one or more selectable icons associated with the one or more answers (Figure 4 element 402 – 432; 438 – 456, Figure 4, paragraph 38 lines 12 – 15, et seq.).

■ Claims 32 – 34 are rejected based on the same rationale discussed in claims 16 and 23 rejections.

■ Regarding claim 35, Miller discloses validating one or more answers (Figure 5 element 507, paragraph 53 lines 2 – 14, paragraph 33 lines 2 – 9; 16 – 19; 22 – 23, et seq.).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANGWOO AHN whose telephone number is (571)272-5626. The examiner can normally be reached on M-F 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Joon H. Hwang/  
for Hosain Alam, SPE of Art Unit 2166

5/22/2008  
/S. A./  
Examiner, Art Unit 2166